IN THE UNITED STATES PATENT & TRADEMARK OFFICE

ART UNIT: 3684 EXAMINER: Benjamin S. Fields APPLICANT: Paul Swenson SERIAL NO.: 10/786,706 FILED: February 25, 2004 CONF. NO.: 3682 FOR: BUSINESS METHOD FOR CHARITABLE FUND RAISING DOCKET NO.: 01841-22363.NP	**CERTIFICATE OF DEPOSIT** DATE OF DEPOSIT: **May 23, 2011** I hereby certify that this paper or fee (along with any paper or fee referred to as being attached or enclosed) is being electronically deposited using EFS Web with the United States Patent Office on the date indicated above. /Christopher L. Johnson/ **Christopher L. Johnson**

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop Appeal Brief – Patents

Sir:

Appellants submit this Reply Brief in response to the Examiner's Answer mailed March 21, 2011 in connection with their appeal from the final rejection of the Patent Office, filed August 26, 2010, in the above-identified application. A Notice of Appeal was filed on November 19, 2010.

I. STATUS OF CLAIMS

Claims 1-2, 4-9, 11-18, 20 and 21 are pending. Claims 1-2, 4-9, 11-18, 20 and 21 stand rejected. Claims 3, 10 and 19 have been cancelled. The claims on appeal in this application are claims 1-2, 4-9, 11-18, 20 and 21.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for review are:

a. Whether independent claims 1 and 21, and dependent claims 2, 4-9 and 11-18 are unpatentable under 35 U.S.C. § 101 as being directed to non-statutory matter;

b. Whether claims 11-12 are unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite.

c. Whether independent claims 1 and 21 and dependent claims 2, 4-9, and 11-18, are unpatentable under 35 U.S.C. § 103(a) as being obvious over, "FREEDOM FIELD" < URL: http://www.bright.net >, March 2001 [retrieved by USPTO on 2005-04-11], retrieved from the internet at: < URL: http://www.archive.org >, hereinafter "Exhibit U", in view of Harmon et al. (US PG Pub. No. 2004/0181468), hereinafter "Harmon."

III. RESPONSE TO EXAMINER'S ANSWER

A. Rejections Under 35 U.S.C. § 101

The Examiner has rejected independent claims 1 and 21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. More particularly, it is asserted that the claimed process does not transform a particular article into a different state or thing. The Examiner asserts in his Answer that the operation of "transforming a selected location by erecting the plurality of flags at the selected location to comprise the healing field …", as recited in independent claims 1 and 21, is not "a physical transformation which satisfies any of the grounds of the 35 U.S.C. 101 statutes." (Examiner's Answer, Page 5, 2nd paragraph). However, the Examiner has not provided any rational argument or legal basis for his assertion. The Examiner's assertion does not stand in view of the current case law.

In the *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc) decision, the en banc court explained the machine-or-transformation test as follows:

> The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See [*Gottschalk v.*] *Benson*, 409 U.S. [63, 70 (CCPA 1972)]. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See [*Parker v.*] *Flook*, 437 U.S. [584, 590 (1978)].

Id. at 961-962.

Regarding the transformation branch of the inquiry, the court explained that transformation of a particular article into a different state or thing "must be central to the purpose

of the claimed process". *Id.* at 962. As to the meaning of "article", the court explained that chemical **or physical transformation of physical objects** or substances is patent eligible under § 101. *Id.* (Emphasis added).

Independent claim 1 recites a method for raising funds for a charitable cause. The process includes the operations of:

> selecting a graphic layout for a healing field that is comprised of a plurality of flags positioned in a predetermined pattern; and
>
> transforming a selected location by erecting the plurality of flags at the selected location to comprise the healing field …

A graphic layout can be designed to arrange the flags for a selected location, such as a public park, around a public or private building, along a lake, a river, a path, or another location that would allow the public to view the healing field. (See specification, page 4, lines 9-12). The selected location can then be transformed by erecting the plurality of flags at the selected location to comprise the healing field.

The limitations in independent claim 1meet each of the requirements for the transformation test that are recited in *Bilski*. Specifically, the transformation of the selected location by erecting the plurality of flags at the selected location imposes meaningful limits on the claims' scope, thereby imparting patent-eligibility. In order to infringe the claim, an infringer must transform a selected location by erecting a plurality of flags. This is a specific, meaningful limitation. Moreover, the act of erecting the flags is not merely an extra-solution activity. Rather, the act is integral to the processes recited in claims 1 and 21. Thus, the act is central to the purpose of the claimed process. In addition, the transformation of the selected location by

erecting the flags involves a physical transformation of physical objects, thereby making it patent eligible under § 101 according to *Bilski*. *Id.*

Independent claim 21 includes similar limitations as claim 1. While claim 21 does not specifically include a "transforming" element, the processes of "selecting a graphic layout for a healing field that is comprised of the plurality of flags positioned in a predetermined pattern" and "displaying the healing field"... is substantially similar to the elements discussed above and meets the same requirements for the transformation test that are listed in *Bilski*.

Thus, in view of the U.S. Supreme Court decisions in Flook, Benson, and Bilski, the claims of the present application impose meaningful limits on the claims' scope, are not merely insignificant extra-solution activity, and involve a physical transformation of physical objects.

Therefore, Appellants submit that the rejection of independent claims 1 and 21 and dependent claims 2, 4-9 and 11-18 under § 101 should be overturned for at least the reasons that were subsequently discussed in this brief, as well as the reasons discussed in the Appeal Brief.

B. Rejections Under 35 U.S.C. § 103(a)

The present application recites a new, novel, non-obvious invention in independent claims 1 and 21 that provides a process for raising funds for a charitable cause. The process involves the creation of a "healing field" for an identified charitable cause. The healing field comprises a plurality of flags that are positioned in a predetermined pattern at a selected location. One or more sponsors fund the charitable cause through paying for the plurality of flags prior to their display. The healing field is then linked to the charitable cause by carrying out a public awareness campaign to associate the charitable cause with the healing field. After the healing field is displayed at the selected location for a predetermined period, at least some of the flags

that are displayed in the healing field (that were paid for by the sponsor(s)) are then sold to raise additional funds for the charitable cause in need of funding.

The process recited in independent claims 1 and 21, has been a tremendously successful fundraising technique for charitable groups across the nation. Many charitable organizations are struggling due, in part, to the rapidly changing media landscape of the 21st century. Changes in consumer behavior have reduced the effectiveness of longstanding efforts to raise awareness of charities using traditional media routes such as newspaper, magazine, radio, and television advertising. As viewership of these traditional media routes has diminished, so too has their effectiveness in assisting charities to raise funds.

The use of the healing field, as used in the processes described in claims 1 and 21, overcomes many of the limitations by placing healing fields in highly visible locations. The creation of the healing field in the selected location often generates advertising in the form of news reports in television, radio, newspapers and internet that add to the public awareness of the healing field. The ability to raise funds through obtaining one or more sponsors to pay for the flags, followed by selling at least some of the flags displayed in the healing field, provides a revenue stream to a charity throughout the display of the healing field.

The present invention recited in independent claims 1 and 21, when taken as a whole, is substantially different from the cited prior art references, which essentially consist of a plan for a permanent 30 acre national park to be located at I-75 Exit 111 in Wapoakoneta, Ohio (Exhibit U), and a patent application that discloses a scheme to scalp tickets for popular events to raise money for charitable events (Harmon). The combination of the "over one-hundred granite memorial markers" and "state and colonial flags located around 5 pools forming the shape of a star" disclosed in Exhibit U, with the ticket scalping scheme disclosed in Harmon, does not

arrive at the fund raising processes disclosed in the present application in claims 1 and 21, which enables a specific charity to raise funds through a temporary display of a healing field at a selected location, such as a park or civic center.

The transformation of the selected location into a healing field can be highly beneficial in raising awareness and generating funds for a charity. It is the change (i.e. transformation) of the selected location that grabs the public's attention. In addition, the temporary nature of the display is necessitated by the fact that the flags are then sold off to raise additional funds. Moreover, the temporary nature allows a healing field to be created and displayed for a wide variety of different types of causes, such as a historical event (9-11), civic events (police, firemen, soldiers), or a cause such as a disease (cancer, degenerative diseases, etc.), or civic problem (child abuse, spousal abuse, etc.). (See specification, page 3, lines 1-13).

In contrast, the permanent 30 acre display in Exhibit U only represents a single narrow cause. The reference only discloses the need to raise money to create the permanent display. There is no mention of raising funds for any type of charity. Nor would the permanent display be especially helpful in catching the eye of the public about a specific cause after the display had opened. Without an eye catching transformation of a selected location, as recited in claims 1 and 21, the public will little notice a permanent display.

The Examiner has done a proficient job in laying out his arguments in the Examiner's Answer. However, portions of the Examiner's Answer seek to break new legal ground in an effort to show that the cited Exhibit U reference discloses the limitations of claims 1 and 21. The Examiner asserts that, in order for the Exhibit U reference to teach that the display is permanent, it must include the word "permanent" in the reference. Specifically, the Examiner argues that "nowhere within Exhibit U does it say that the freedom field is permanent." (Examiner's

Answer, page 22, lines 6-14). While the word "permanent" may not be specifically used, it stretches the imagination that a 30 acre park comprised of hundreds of granite markers, 8 foot wide paved pathways, and five lakes in the form of a star is somehow going to be moved.

The Examiner further argues against specific statements in Exhibit U that teach and suggest the permanence of the planned display. Specifically, Appellant noted in the Appeal Brief that Exhibit U discloses that future generations will be able to view the display comprised of granite markers and lakes. (See Exhibit U, Page 3). The Examiner again stretches the bounds of credibility, arguing that this statement doesn't certify that future generations can see the display, so therefore, it must be temporary. (Examiner's Answer, page 22, lines 6-14). Appellant urges the Board of Patent Appeals and Interferences to overturn the Examiner's strained attempts at showing that each and every element of independent claims 1 and 21 are disclosed in the cited references. It is clear that neither Exhibit U nor the Harmon reference teaches or suggests a temporary display of a plurality of flags.

For the foregoing reasons, Appellant submits that the Examiner's assertions are in error and respectfully requests that the Appeals Board overturn the rejection.

IV. CONCLUSION

Appellant respectfully submits that the claims on appeal are patentably distinct from the asserted prior art references. Particularly, the present invention, as recited in independent claims 1 and 21, are processes that are eligible for patent protection under 35 U.S.C. § 101. Moreover, none of the asserted references or combinations of references motivates, teaches, or suggests one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 to arrive at the presently claimed invention, as a whole. Appellant contends that Exhibit U and Harmon, either individually or in combination, fail to teach each and every element of the claimed invention.

For these reasons, Appellants respectfully request that the Board of Appeals reverse the rejection and remand the case to the Examiner for allowance.

Dated this 23rd day of May, 2011.

/Christopher L. Johnson/

Christopher L. Johnson
Attorney for Appellants
Registration No. 46,809

THORPE NORTH & WESTERN, LLP
Customer No. 20,551
P.O. Box 1219
Sandy, Utah 84091-1219
Telephone (801) 566-6633

CJ/AH/ac